

REMARKS

In the Examiner's Answer dated March 22, 2006 the patentability of claims 1-28 were addressed. Claims 9, 12, 18, and 21 were objected to as containing an informality. Claims 13 and 15-21 were rejected under 35 U.S.C. §101. Claims 1-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Elnozahy et al.*, U.S. Patent No. 6,701,421, in view of *Sayles*, U.S. Patent No. 6,549,963.

I. Objection of Claims 9, 12, 18, and 21

In the Examiner's Answer dated March 22, 2006, the Examiner objected to claims 9, 12, 18, and 21 as containing an informality. More specifically, the Examiner stated that the references in these independent claims to the respective first and second descriptors may have been incorrectly reversed. Applicants have amended claims 9, 12, 18, and 19 to correct the references to the first and second descriptors. Accordingly, Applicants respectfully request that the Examiner remove the objection to claims 9, 12, 18, and 19.

II. Rejection of Claims 13 and 15-21 under 35 U.S.C. §101

In the Examiner's Answer dated March 22, 2006, the Examiner raised a new ground of rejection rejecting claims 13 and 15-21 under 35 U.S.C. §101. More specifically, the Examiner has asserted that the claimed invention is directed to non-statutory subject matter. Applicants have amended claim 13 to remove the language "signal bearing", and Applicants have canceled claim 15. Accordingly, Applicants hereby request removal of the rejection of claim 13, and 15-21 under 35 U.S.C. §101.

III. Rejection of Claims 1-28 under 35 U.S.C. §103(a)

In the Examiner's Answer dated March 22, 2006, the Examiner maintained the rejection of claims 1-28 under 35 U.S.C. §103(a) over *Elnozahy et al.* in view of *Sayles*.

The remarks pertaining to *Elnozahy et al.* and *Sayles* in the prior communications are

hereby incorporated by reference.

A. *Elnozahy et al.* as a prior art reference

U.S. Patent Application No. 6,701,421 to *Elnozahy et al.* was filed before the U.S. Patent and Trademark Office on August 17, 2000. *Elnozahy et al.* is owned by International Business Machines Corporation. Applicants filed their application before the U.S. Patent and Trademark Office on December 28, 2000, and each of the Applicants have assigned their rights to International Business Machines Corporation.

Under 35 U.S.C. §103(c),

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Based on the above, it is Applicants’ position that *Elnozahy et al.* does not qualify as a prior art reference under 35 U.S.C. §102(b), and therefore should have been cited under subsection 102(e), in which case it would have fallen under the exemption for commonly owned patents and applications set forth in 35 U.S.C. §103(c). Accordingly, Applicants respectfully request removal of the rejection of claims 1-28 under 35 U.S.C. §103(a).

B. Motivation to combine *Elnozahy et al.* in view of *Sayles*

It is accepted that for a rejection under 35 U.S.C. §103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings. See MPEP §2143. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure”. MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted, *Elnozahy et al.* fails to teach both the first and second descriptor in a computer system as claimed by Applicants. The Examiner has brought in the *Sayles* patent to support the missing

descriptor of *Elnozahy et al.*, as claimed by Applicants and not taught in *Elnozahy et al.*

Applicants contend that there is no motivation for combining the prior art references to negate patentability herein. The motivation for such a combination stems from the language in Applicants' claims. Clearly, *Elnozahy et al.* is the primary reference and *Sayles* is the secondary reference being applied by the Examiner. *Elnozahy et al.* teaches firmware that at most produces one of the descriptors, as claimed by Applicant. There is no teaching or suggestion in *Elnozahy et al.* to modify their invention for the specific descriptors as produced by firmware and as claimed by Applicants. Modifying the teaching of *Elnozahy et al.* for generating the omitted descriptor as claimed by Applicants would go against the teaching of *Elnozahy et al.* Applicants' invention focuses on firmware that produces two specific descriptors in a single computer system, whereas *Elnozahy et al.* teaches BIOS is responsible for creating configuration tables that identify hardware components of the system and the size of the system memory. See Col. 4, lines 6-9. However, the MPEP provides:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352).

MPEP §2143.01. Similarly, the suggested combination of *Elnozahy et al.* with *Sayles* would require a substantial reconstruction and redesign of the firmware in *Elnozahy et al.* for generating the second descriptor in a manner not envisioned or contemplated by *Sayles*. Accordingly, it is Applicant's position that there is no motivation present in *Elnozahy et al.* to be modified in the manner as claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicants' pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *Elnozahy et al.*

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicants' specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicants respectfully contend that the combination of *Elnozahy et al.* and *Sayles* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 1-28 under 35 U.S.C. §103(a).

IV. Conclusion

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner indicate allowability of claims 1-28, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicant respectfully requests that the outstanding rejections be withdrawn and this application be passed to issue.

Respectfully submitted,

By: /Rochelle Lieberman/

Registration No. 39,276
Attorney for Applicants

Lieberman & Brandsdorfer, LLC
802 Still Creek Lane
Gaithersburg, MD 20878
Phone: (301) 948-7775
Fax: (301) 948-7774
Email: rocky@legalplanner.com

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